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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,683	01/08/2004	Hirofumi Muratani	247273US2SRD DIV	5927
22850	7590	11/28/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GYORFI, THOMAS A	
			ART UNIT	PAPER NUMBER
			2135	
			NOTIFICATION DATE	DELIVERY MODE
			11/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/752,683	Applicant(s) MURATANI, HIROFUMI	
	Examiner Tom Gyorfi	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8, 14-19 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8, 14-19 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/4/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 4-8, 14-19, and 23-27 remain for examination. The correspondence filed 9/4/07 amended claims 4, 5, 14, and 19.

Information Disclosure Statement

2. The information disclosure statement (IDS) originally filed in parent application 09/658,565 on 4/3/03, which shows that the Shen reference had been considered by the Examiner of that application is acknowledged. Consequently, this Examiner's objection to the IDS filed in the instant application on 1/8/04 is hereby withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The claim is directed toward "a method for detecting an embedded code", yet the second limitation in the claim pertains to "dividing the embedded code into the plurality of component codes"; this limitation assumes that the embedded code from the received predetermined content in the first limitation has already been detected, while all subsequent limitations of the claim have no discernible use for "detecting an embedded code" as stated in the preamble. There are no limitations

between “receiving said predetermined content...” and “dividing the embedded code...” which are necessary in order to realize the stated purpose of the method.

5. Claims 5-8, 14-19, and 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Similar to claim 4, these claims recite “a unit for detecting an embedded code”, but fail to recite how said embedded code is detected; rather the existing claim limitations assume *a priori* knowledge of the existence of the claimed embedded code and subsequently perform additional mathematical operations that are irrelevant to the stated purpose of “detecting an embedded code” as claimed.

6. With regards to the above rejections, Examiner further observes that although the specification discloses that watermarks embedded into digital content can comprise user identification numbers (page 29, lines 15-27), it is not clear that the user identification number being calculated in the claims is in fact part of the claimed embedded code; rather, it would appear that the claimed user identification number is at best a duplicate of a user identification number that could be present in the embedded code, if the embedded code is understood to be the watermark discussed in the instant specification. If this is what Applicant intends to be the case, then the claims are still rejected under 35 USC 112, 2nd paragraph as the claims omit essential steps that would recite how the calculated user identification number would subsequently be used to detect an embedded code. Thus, either the body of the claims are incomplete, or the preamble to the claims is inaccurate.

7. It is further observed that Applicant appears to have invoked 35 USC 112, 6th paragraph with respect to claims 5-8, 14-19, and 23-27; however, it does not appear that the specification identifies any structure which corresponds to the recited means. Clarification by Applicant is respectfully requested as to whether 35 USC 112, 6th paragraph was meant to be invoked; and if so, where in the specification the requisite structures for the recited means are disclosed.

Claim Rejections - 35 USC § 101

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 4-8, 14-19, and 23-27 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. As discussed above, the claims are directed toward a method and/or unit "for detecting an embedded code"; however, the claims fail to recite any steps that would accomplish the stated objective. Furthermore, the end result of each claim appears to be the computation of a "user identification number", but the claims fail to recite any use whatsoever for this result, let alone that it might be useful in "detecting an embedded code". As the claims currently stand, they have neither a specific nor substantial utility [see MPEP 2107.01(I)].

10. Claims 4-8, 14-19, and 23-27 are also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 4 was amended to recite the existence of an "external device" to provide predetermined content; however, it is clear that the recited external device does not

actually implement any of the remaining limitations of the claim. As such, the claim is still directed toward an abstract idea or mathematical algorithm *per se* rather than the practical application of the abstract idea or mathematical algorithm and as such, is not patentable. See MPEP 2106.

Claims 5-8, 14-19, and 23-27 appear to invoke 35 USC 112, 6th paragraph, to employ "means plus function" language to describe the elements of the claimed unit; however the specification appears to lack sufficient description as to the exact structure of the claimed means. Each element in the claims is disclosed in the specification as a "section", but Examiner could find no definition in the instant specification as to what exactly comprises a "section". Furthermore, Examiner observes that the only definition of the term "unit" as provided by the specification refers to a series of bits (specification, page 22); absent any alternative definition, it would appear that any claimed "unit" is intended to refer to a software *per se* embodiment of the instant invention, which is non-statutory. It is also noted that the terms "input port" and "output port", when understood in the context of a communications network as relied upon by the Applicant to resolve the previous 35 USC 101 rejection (again see the amendment of 9/4/07, footnote 1; cf. specification, page 36, lines 15-26), are themselves abstract ideas represented by a series of bits (see the enclosed Comer reference). Thus the amended claims fail to remedy the original problem of the claims encompassing non-statutory subject matter, i.e. software *per se*.

Allowable Subject Matter

11. Claims 4-8, 14-19, and 23-27 would be allowable over the prior art, pending resolution of the rejections above.
12. Please refer to pages 3-4 of the Office Action of 6/4/07 regarding the Examiner's statement of reasons for allowance of the claims.¹

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: "Internetworking with TCP/IP, Volume I", Third Edition, by Douglas Comer, explains that the concept of ports, in the context of communications networks, are abstract concepts represented as sequences of bits (integers), and thus conform to the instant specification's definition of "unit" as a software *per se* construct.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


¹ The Office Action of 6/4/07 contains a typographical error on page 4, wherein it indicates that the dependent claims are allowable "by virtue of their dependence on claims 9 and 14." Examiner had intended to refer to claims "5 and 14" instead. Examiner apologizes for the error.

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TAG
11/16/07


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